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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,262	07/18/2006	Giuseppe Bordinon	6706/007	8489

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EXAMINER
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KRUER, STEFAN

ART UNIT	PAPER NUMBER
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3654

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/597,262		BORDIGNON ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Stefan Krueer		3654	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17 - 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17 - 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>29 Sept. 2006</u> .                                           | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Priority*

It is noted that this application appears to claim subject matter disclosed in prior Application No. PCT/IB2005/000105, filed 18 January 2005 claiming priority to a foreign Application No. UD2004A000007. A reference to the prior application(s) must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76).

Since the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c).

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Furthermore, a certified copy of the Italian patent application, UD2004A000007, to which the international application claims priority, is requested.

### ***Specification***

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show in Figure 4 that "The annular tooth 31... has a ... height H substantially equal to the diameter of the metal wire 10..." as described in the specification (Page 10, L. 29 - 31). With respect to element 13 of Figures 2 and 3, said element of Figure 2 is referenced as an "inner plate" whereas in Figure 3 it is named a "containing element". Though the designations are analogous, the use of unique terms is questionable. Furthermore, the containing element (13) of Figures 2 – 4 is not indicated in Figure 1.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 17, 20 - 28 and 29 - 31** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **Claims 21 – 22, 27 – 36 and 37 - 40**, with respect to claims directed to an apparatus and a method of using said apparatus, of copending Application No. 10/597228 as well as **Claims 11, 13 – 17 and 18 - 19**, in similar respect, of copending Application No. 10/597184.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

### ***Claim Objections***

**Claim 29** is objected to because of the following informalities:

- In Line 3, “an” of “an containing...” should be an “a”.
- In Line 5, “a” of “at least a guide...” should be a “one”.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 23 – 28** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 26** recites the limitation "the protrusion... is substantially equal to a value..." whereby said protrusion, as understood, is a structure that cannot have a value. As understood from the disclosure, the protrusion comprises a thickness or height of an amount in relation to the diameter of a metal product.

**Claims 23 and 24**, Line 4 and 2, respectively, recite the limitation "the" in "the lower part" and "the outside". There are insufficient antecedent bases for these limitations in the claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 17 – 22 and 29 - 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bordignon et al (6,318,660).

**Re: Claim 17**, Bordignon et al disclose a device (10, Fig. 1) for coiling a windable long, metal product (12), comprising:

- a mandrel (20) having a substantially circular transverse section and rotating around a horizontal, vertical or inclined axis (about 20a),

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- a containing element (24) to contain said metal product, arranged in correspondence with said mandrel and substantially orthogonal to said axis,
- and at least a guide and containing device (39 and/or 40) able to be driven between a first working position in which said guide and containing device cooperates with said mandrel (Col. 4, L. 14 – 18), and a second inactive position in which said guide and containing device is arranged distant from said mandrel (Col. 4, L. 18 - 22),
- wherein said containing element comprise an annular channel which is made in proximity with an outer surface of said mandrel and is coaxial with the axis of rotation of said mandrel (Col. 4, L. 12 – 23).,
- and wherein said guide and containing device comprises a groove that is able to define an accompanying guide for said metal product along an outer circumference of said mandrel towards said annular channel and coaxial with said annular channel, when said guide and containing device is in said first working position. (Col. 4, L. 12 – 23).

**Re: Claims 18 - 19**, Bordignon et al disclose:

- wherein said annular channel has a substantially rectangular transverse section (Col. 1, L. 6),
- wherein said annular channel has a substantially trapezoid section (Col. 1, L. 6), respectively.

**Re: Claims 20 - 22**, Bordignon et al disclose:

- wherein said guide and containing device comprises at least a first flap (39),
- wherein said guide and containing device comprises a second flap (40) arranged diametrically opposite said first flap, and
- wherein said first and second flap constitute, in said first working position, a lateral cover to said annular channel (Col. 5, L. 7), respectively.

**Re: Claim 29**, Bordignon et al disclose a method for coiling a long metal product, performed by means of a coiling device (10) which comprises:

- a mandrel (20) having a substantially circular transverse section and rotating around a horizontal, vertical or inclined axis,
- a containing element (24) to contain said metal product, arranged at one end of said mandrel and substantially orthogonal to said axis, and at least one guide and containing device (39 and/or 40), able to be driven between a first working position in which said guide and containing device cooperates with said mandrel, and a second inactive position in which said guide and containing device is arranged distant from said mandrel,
- said method comprising the following steps:
  - a first step wherein a leading end of said metal product is inserted into a groove of said guide and containing device arranged in said first working position to guide said metal product along an outer circumference of said mandrel;
  - a second step wherein said metal product is guided by said groove inside an annular channel made on said containing element in proximity with an outer surface of said mandrel and coaxially with said axis of rotation of said mandrel;
  - a third step wherein an initial segment of said metal product is gripped and clamped in said annular channel by means of friction forces generated between said metal product and the walls of said annular channel;
  - a fourth step wherein said metal product is wound onto said mandrel for a pre-determined segment of length (Col. 5, L. 8);
  - a fifth step wherein said guide and containing device is taken from said first working position to said second inactive position (Col. 5, L 10); and
  - a sixth step wherein said metal product is wound for the remainder of its length (Col. 21 – 27).



**Re: Claim 30**, Bordignon et al disclose wherein during said first step, said metal product is inserted into said groove by means of a distributor (45) of said metal product.

**Re: Claim 31**, Bordignon et al disclose wherein during said first step, said mandrel is in rotation around its own axis.

**Re: Claim 32**, Bordignon et al disclose wherein said segment of pre-determined length is between a fraction of one spiral and three spirals (Col. 5, L. 8).

With respect to a rejection under obviousness in lieu of anticipation, in view of the claimed "annular channel" and "groove", in that the apparatus of Bordignon et al discloses an apparatus performing in the manner as claimed and broadly as disclosed by the instant invention, though silent with respect to an annular channel and groove, in view of the "... rolled stock 12 is... to enter into the inner cavities of the guides.... and to be guided in the coiling step of the first revolutions of the mandrel" and that retaining the rolled stock is inherent to frictional interaction of the rolled stock with the "wear-resistant materials" that comprise the "inner cavities of the guides", the instant invention as claimed in view of Bordignon et al would have been obvious to one having ordinary skill in the art.

### ***Allowable Subject Matter***

**Claims 23 - 28** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims as well as to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Castellani (7,246,767) is cited for a device for coiling a long metal product wherein a flange is applied on a containing element substantially perpendicular to a mandrel and shaped so as to have an annular tooth substantially coaxial with said mandrel, said annular tooth defining at a lower part an annular channel and said tooth is slightly convergent towards an outside.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Kruer whose telephone number is 571.272.5913. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571.272.6856. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866.217.9197 (toll-free).

/Stefan Kruer/

Examiner, Art Unit 3654

01 September 2008

/Peter M. Cuomo/

Supervisory Patent Examiner, Art Unit 3654